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JUL 14 2010

OFFICE OF PETITIONS

In re Application of	:	
Patrick G.I. Perdu	:	
Application No. 10/633351	:	DECISION DISMISSING
Filing or 371(c) Date: 08/01/2003	:	PETITION UNDER
OFFLINE MARKLESS POST	:	37 CFR 1.47(b)
PROCESSING OF PRINTED MEDIA	:	

This is in response to the Petition Pursuant to 37 C.F.R. 1.47(b) Sole Inventor Cannot be Found," filed March 1, 2004, and supplemented May 12, 2004, to allow a person to whom an inventor has assigned or agreed in writing to assign the invention, or who otherwise shows sufficient proprietary interest in the matter justifying such action, to make application on behalf of and as agent for all inventors.

The petition is **dismissed**.

Rule 47 applicant is given TWO (2) MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(b)", and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor. Failure to respond will result in abandonment of the application. Any extensions of time will be governed by 37 CFR 1.136(a).

Background

The above-identified application was filed on August 1, 2008, without an executed oath or declaration. This Office mailed a Notice to File Missing Parts of Nonprovisional Application (hereinafter "Notice") on October 30, 2003, requiring, *inter alia*, a properly signed oath or declaration and a late filing fee, oath or declaration and surcharge.

In response to the Notice, Applicant files the present petition and as proof of proprietary interest in the invention by Xerox Corporation, provide a copy of a "XEROX Invention Proposal Form" executed by the inventor. Petitioner supplemented the present petition with a copy of the inventor's employment agreement with European Engineering Systems S.A. Petitioner provides that XEROX obtained the services of the inventor through European Engineering Systems S.A.

Applicable Law, Rules and MPEP

The applicable Law, 35 U.S.C. 118, Filing by other than inventor, states:

Whenever an inventor refuses to execute an application for patent, or cannot be found or reached after diligent effort, a person to whom the inventor has assigned or agreed in writing to assign the invention or who otherwise shows sufficient proprietary interest in the matter justifying such action, may make application for patent on behalf of and as agent for the inventor on proof of the pertinent facts and a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage; and the Director may grant a patent to such inventor upon such notice to him as the Director deems sufficient, and on compliance with such regulations as he prescribes.

The applicable Rule, 37 CFR 1.47(b) requires: (1) proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings); (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116; (3) the petition fee; (4) a statement of the last known address of the non-signing inventor(s); (5) proof of proprietary interest; and (6) proof of irreparable harm. Applicant lacks item (5) as set forth above.

As to item (5), Applicant failed to show or provide proof that XEROX Corporation ("XEROX"), or anyone other than the inventor, has sufficient proprietary interest in the subject matter to justify the filing of the application (*see* MPEP 409.03(f)). No assignment for the present invention has been filed. The MPEP 409.03(f), Proof of Proprietary Interest, states:

When an application is deposited pursuant to 37 CFR 1.47(b), the 37 CFR 1.47(b) applicant must prove that
(A) the invention has been assigned to the applicant, or
(B) the inventor has agreed in writing to assign the invention to the applicant, or
(C) the applicant otherwise has sufficient proprietary interest in the subject matter to justify the filing of the application.

Here, Petitioner does not assert that the invention has been assigned to XEROX, or that the inventor has agreed in writing to assign the invention. Instead, Petitioner attempts to demonstrate a sufficient proprietary interest in the application to allow petitioner to make application on behalf of and as agent for the inventor. As proof of proprietary interest in the invention by Xerox Corporation, Petitioner provides a copy of a "XEROX Invention Proposal Form" executed by the inventor. However, the Invention Proposal Form is an invention proposal form, and fails to demonstrate a sufficient proprietary interest in the present application to allow petitioner to make application on behalf of and as agent for the inventor. Petitioner supplemented the present petition with a copy of the inventor's employment agreement with European Engineering Systems S.A. Petitioner provides that XEROX obtained the services of the inventor through European Engineering Systems S.A. However, the inventor's employment agreement with European Engineering Systems S.A. fails to demonstrate a sufficient proprietary interest by XEROX in the present application to allow petitioner to make application on behalf of and as agent for the inventor.

The MPEP 409.03(f) provides as follows:

Where the invention has not been assigned, or if there is no written agreement to assign, the 37 CFR 1.47(b) applicant must demonstrate that he or she otherwise has a sufficient proprietary interest in the matter.

A proprietary interest obtained other than by assignment or agreement to assign may be demonstrated by an appropriate legal memorandum to the effect that a court of competent jurisdiction (federal, state, or foreign) would by the weight of authority in that jurisdiction award title of the invention to the 37 CFR 1.47(b) applicant. The facts in support of any conclusion that a court would award title to the 37 CFR 1.47(b) applicant should be made of record by way of an affidavit or declaration of the person having firsthand knowledge of same. The legal memorandum should be prepared and signed by an attorney at law familiar with the law of the jurisdiction involved. A copy (in the English language) of a statute (if other than the United States statute) or a court decision (if other than a reported decision of a federal court or a decision reported in the United States Patents Quarterly) relied on to demonstrate a proprietary interest should be made of record. (Emphasis supplied).

Conclusion

Petitioner has failed to demonstrate that it has a sufficient proprietary interest in the present application to allow petitioner to make application on behalf of and as agent for the inventor. Petitioner must provide a legal memorandum signed by an attorney familiar with the law of the jurisdiction stating that a court of competent jurisdiction would by the weight of authority in that jurisdiction award the title of the invention to the Rule 47(b) applicant.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop PETITIONS
 Director for Patents
 PO Box 1450
 Alexandria, VA 22313-1450

By FAX: (571) 273-8300
 Attn: Office of Petitions

By hand: Customer Service Window
 Randolph Building
 401 Dulany Street
 Alexandria, VA 22314

Telephone inquiries concerning this matter should be directed to the undersigned at (571) 272-3232.

/Derek L. Woods/

Derek L. Woods
Attorney
Office of Petitions